



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,728	07/31/2001	Tatsuo Yoshino	0905-0264P	1252

2292 7590 09/22/2005

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
----------

QIN, YIXING

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,728

Applicant(s)

YOSHINO, TATSUO

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-4, 7, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”)

#### 1. Claim 1

- Fredlund ‘215 discloses in column 4, lines 46-54 that a client computer can access images from a storage device 28 through a communication channel. One can see in figure 1B that this is a mass storage device (e.g. a database). Although it is not inside a server, one of ordinary skill knows that this storage device can easily be implemented into a server computer (such as computer 26 in Fig. 1b).
- Fredlund ‘215 discloses in column 4, line 53 a CRT for display
- Fredlund ‘215 discloses in column 6, lines 50-53 a modem for sending an order.
- Although not explicitly disclosed, the server (i.e. computer 26) would inherently have a storage device, such as a hard disk, for storing image information (see also column 7, lines 18-21).
- As mentioned in column 7, lines 18-21, the computer 26 controls a printer. Although not explicitly disclosed, it would be obvious that the placing of the order entails a print command since a user would want the placed order to be printed. The motivation is that an “order” can be used to indicate a request for a physical copy of the wanted images, i.e. command to print an item.
- Again, in column 7, lines 18-21, the computer 26 controls a printer. This would mean that the computer would inherently have a controller (e.g. could be a printer driver) to control the printer.

#### 2. Claim 2

- These limitations have been addressed in claim 1.

Art Unit: 2622

**3. Claim 3**

- Fredlund '215 discloses in column 2, lines 37-40, the selection of a desired number of prints.

**4. Claim 4**

- Fredlund '215 discloses in column 2, lines 42-44 and column 6, lines 27-28. The photofinisher is where the server computer 26 would be.

**5. Claim 7**

- Fredlund '215 discloses in column 4, lines 46-54 that images are transferred from a server to a CRT. The server sends low resolution images (line 49) to the CRT to display. These images have already been converted in advance, see column 3, lines 64-67 and column 4, lines 1-35.

**6. Claim 14**

- These limitations have been addressed in claim 1.

**7. Claim 15**

- These limitations have been addressed in claim 1.

**8. Claim 16**

- These limitations have been addressed in claim 1.

**9. Claim 17**

- These limitations have been addressed in claim 1.

II. Claim 5 is are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund '215”) in view of Tamura et al (U.S. Patent No. 6,771,896 – “Tamura”)

**10. Claim 5**

- Fredlund '125 does not explicitly disclose a means for calculating a planned completion date. However, Tamura, discloses in column 12, lines 1-8 that an electronic camera (i.e. client) can receive date of completion information from a photofinisher (i.e. server). A date of completion would have to be calculated before it would be sent.
- Both references are in the art of photofinishing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have a planned completion date in Fredlund '125's invention. The motivation would be to let an user know when he/she can have the prints ready.

Art Unit: 2622

III. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”) in view of Ueda et al (U.S. Patent No. 6,429,923 – “Ueda”)

**11. Claim 6**

- Fredlund does not explicitly disclose a means for requesting order condition information. However, Ueda, discloses in column 44 lines 17-35 that a client computer can make a server computer transmit order contents information (line 20). One would understand that this information is stored in the hard disk of the server.
- Both references are in the art of photofinishing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have a order transmission mechanism for transferring order content information. The motivation would be to let an user verify his/her order.

IV. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”) in view of Motegi (U.S. Patent No. 6,307,640)

**12. Claim 8**

- Fredlund ‘215 discloses in column 4, lines 33-35, discloses the storage of the images in the storage device 28. Storing would mean the registration of the image data.
- Fredlund ‘215 discloses in column 3, lines 32-36 the generation of an image ordering id (i.e. the image ordering ID).
- Fredlund ‘215 does not explicitly disclose a print commanding ID. However, the Motegi reference, discloses in Fig. 3 item S2, the registering of a job number. This can be a print commanding ID since it designates which job to print.
- Fredlund ‘215 discloses in column 4, lines 46-54 the requesting of images from the server. Lines 46-47, especially, discloses that appropriate identification is needed and it would be obvious that this could be the order number.
- Motegi, again, discloses in Fig. 3, items S5 and S6, the printing of an image according to a job number.
- Both references are in the art of remote printing of images. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have integrate a print commanding ID into Fredlund ‘125. The motivation would

Art Unit: 2622

be to have additional protection features to ensure the integrity of user data and requests.

**13. Claim 9**

- Fredlund '215 discloses in column 3, lines 34-35 the generation of a unique customer identification number. It would be obvious that this corresponds to the customer order number.
- Motegi discloses in Fig. 3, items S2 and S3 the receiving and registration of a password according to a job number (i.e. print commanding ID).
- Fredlund does not explicitly disclose any judging means for the customer identification number. However, Motegi discloses in Fig. 3 items S8-S10 that there is a judgment of whether a job number/password combination matches with that stored on the server. It would be obvious to apply this to the customer identification number in Fredlund. Also, it would be obvious that if inappropriate identification is entered in the Fredlund invention, the images would not be transferred from the server to the client.
- The image transmission was discussed above in claim 8 (see column 4, lines 46-54).
- Motegi discloses in Fig. 3 item S8, S9 and S11 the printing of an image based upon a proper job number/password combination.

V. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund '215”) in view of Motegi (U.S. Patent No. 6,307,640) and further in view of Chui et al (U.S. Patent No. 6,657,702).

**14. Claim 10**

- Neither Fredlund '215 nor Motegi discloses the generation of a member specifying ID. However, the tertiary reference, Chui discloses in Fig. 6 and column 18, lines 25-47 the use of a data table to keep member information. Lines 39-43 discloses that virtually any pertinent information can be stored. This makes it obvious that the member information can be stored with ordering information.
- Chui further discloses in column 16, lines 49-66 the association of image with a particular alias (i.e. member ID) – that is the user provides member ID information along with images associated with that member ID.
- All three references are in the art of photofinishing and facilitation of prints based on customer requests. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included member information. The motivation would be to allow various groups access to different and/or specific images on a server based upon the credentials of that group.

Art Unit: 2622

VI. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”) in view of Motegi (U.S. Patent No. 6,307,640) and further in view of Fredlund et al (U.S. Patent No. 6,154,295 – “Fredlund ‘295”)

**15. Claim 11**

- Neither Fredlund ‘215 nor Motegi discloses the erasing of stored images after a predetermined period has elapsed. However, Fredlund ‘295 teaches this in column 3, lines 47-53.
- All three references are in the art of photofinishing and facilitation of prints based on customer requests. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a feature in Fredlund ‘125 to have the server erase images after they have been stored there for a certain amount of time. The motivation would be to enable the server to free up space since the passing of a period time without any orders on that images is a good indication that the customer does not want to make any orders of those images.

**16. Claim 12**

- In addition to the above in claim 11, Fredlund ‘295 also discloses in column 4, lines 43-47 that files would be automatically deleted after a predetermined period of time, which can be a month as mentioned in column 3, lines 47-53. The identification of this time period reads on the fact that there is a confirmation of sorts that lets the user know when his/her images would be deleted.

**17. Claim 13**

- Fredlund ‘295 discloses in column 3, lines 56-57 that if any service is ordered (can read on printing), then the maintenance of the digital negative is extended.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.


The examiner can normally be reached on M-F 9:30-6:00.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600